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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/871,560      | 05/31/2001  | Daniel Alroy         |                     | 4109             |

7590

04/17/2006

DANIEL ALROY  
19 STANTON STREET  
NEW YORK, NY 10002

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| EXAMINER |
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LIN, JERRY

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| ART UNIT | PAPER NUMBER |
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1631

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/871,560

Applicant(s)

ALROY, DANIEL

Examiner

Jerry Lin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

2. Applicants' arguments, filed February 6, 2006, have been fully considered and they are not deemed to be persuasive. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

New matter is subject matter not disclosed in the originally filed application. See MPEP §703.03(o). The applicant has not cited specific passages in the specification that support the instantly claimed method. The method steps of Claim 6 do not appear to be disclosed in the specification nor are the steps disclosed in the original claims. Thus, claim 6 is new matter.

#### Response to Arguments

5. The Applicant has responded to this rejection by citing particular passages in the specification. However, none of the cited passages mention the steps required in claim 6. Rather the passages provide the purpose of the claimed invention, the asserted utility of the invention, as well as the background of the invention. The specification must describe the invention that supports the claims. In other words, in a method claim, the method steps must be described in the specification.

This rejection is maintained from the previous office action.

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6. Claim 6 is also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The instant specification does not teach one of ordinary skill in the art how to establish correspondence between the submodality element of sensation and the external stimulus that normally elicits and a voluntary behavioral response. One of ordinary skill in the art would have to conduct undue experimentation to establish the correspondence between these elements. Without further guidance or positive active steps, the instant specification does not enable one of ordinary skill in the art to use the claimed method.

Furthermore, although the instant specification describes methods to detect brain loci that manifest increased activation as well as identifying brain loci whose deactivation selectively eliminates a behavioral response in mice, the specification does not teach any other methods of identifying brain loci whose deactivation selectively eliminates behavioral response. Given that the brain is a complex organ where different species may have different types of responses or different functions, the actual steps required to apply the instantly claimed method is unpredictable. Thus, one of ordinary skill in the art would have to perform undue experimentation in order to find a method of identifying brain loci whose deactivation selectively eliminates behavioral response without additional guidance or positive steps from the specification.

Response to Arguments

7. The Applicant has responded to this rejection by citing particular passages in the specification. However, none of the cited passages mention how to carry out the steps required in claim 6. Rather the passages provide the purpose of the claimed invention, the asserted utility of the invention, as well as the background of the invention. The specification must teach one of skill in the art how to carry out the steps of claim 6 in order for the claimed invention to be enabled.

This rejection is maintained from the previous office action.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Trivedi et al. (US Patent 4862359).

Trivedi et al. teach a method that includes establishing a correspondence between sensation and stimulus and behavioral response (column 13, lines 15-22); detecting immediately following an external stimulus and corresponding behavioral response, brain loci that manifest increase activation (in the form of a topological map (column 3, lines 40-45; column 10, lines 49-56; column 14, lines 14-24; column 18, lines

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12-64); and identifying the brain loci eliminates a behavioral response to an external stimulus (column 18, lines 12-64).

The Examiner has given claim 6 the broadest reasonable interpretation based on the language of the claim. Given this interpretation, Trivedi et al. teach all the limitations of instant claim 6. Thus Trivedi et al. anticipates the instant claim 6 and the claim is rejected under 35 U.S.C. 102 (b).

#### Response to Arguments

10. The Applicant has responded to this rejection by stating that the subject matter between the reference the application is different, that Trivedi et al. does not address innateness, and that Trivedi et al. patent is confined to gross structures and the instant application is not. The Examiner will address each of the points in turn.

The applicant first states that Trivedi et al. do not mention submodality elements of sensations or elementary mental states. A references does not have to use the precise language of the claim in order to anticipate the claim. If the reference teaches a limitation that is within the scope of the claim, even if that limitation uses different words, that reference anticipates the claim. In this case, submodality elements of sensations or elementary mental states include vision, according to the instant specification on page 9. Trivedi et al. disclose simulations that include visual perception (column 13, lines 15-22). Thus Trivedi et al. disclose submodality elements of sensations according to the characterization provided in the instant specification.

The applicant then states that the notion of innateness is central to the present invention, and that Trivedi et al. do not address innateness. Again, a reference does not have to use the precise language of the claim in order to anticipate the claim. In this case, innateness may be a visual perception according to the specification on page 9. Since Trivedi et al. disclose simulations that include visual perception (column 13, lines 15-22), Trivedi et al. also include innateness in their method.

In addition, the recitation "innate" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Finally the applicant states that Trivedi et al. is confined to gross structures and that the instant claim is applicable to neural clusters. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., loci of neural clusters) are not recited in the rejected claim(s) method steps. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The instant claim only specifies deterring the brain loci and does not mention anything about the order of magnitude of the resolution level.



This rejection is maintained from the previous office action.

### ***Conclusion***

This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply,

or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 10:00am-6:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D. can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Representatives are available to answer your questions daily from 6 am to midnight (EST). When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within

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5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center at (800) 786-9199.

MICHAEL BORIN, PH.D  
PRIMARY EXAMINER



JL